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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 09/893,252 | 06/27/2001 | Peter Styczynski | 00216-552001 / H-245 (KAY) | 1872 |
| 26161 | 7590 | 02/14/2005 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | YU, GINA C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/893,252 | Applicant(s) STYCZYNSKI ET AL. | |
| | Examiner Gina C. Yu | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,10,11,14,20 and 33-48 is/are rejected.
- 7) ☒ Claim(s) 2-5, 7-9, 12, 13, 15-19 and 21-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of response filed on October 21, 2004. Claims 1-48 are pending. Claim rejections made under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated May 19, 2004, are maintained for the reasons of record.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, 33-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Styczynski et al. (US 6020006) in view of Black (WO 99/19466).

Rejection is maintained for the reasons of record.

Claim 20 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Styczynski et al. in view of Black as applied to claims 1, 7, 33-48 above, and further in view of von Borstel et al. (US 6702705).

Rejection is maintained for the reasons of record.

Claim 11 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Styczynski et al. in view of Black as applied to claims 1, 7, 33-48 above, and further in view of Stuyver et al. (US 6713251).

Rejection is maintained for the reasons of record.

Claim 10 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Styczynski et al. in view of Black as applied to claims 1, 7, 33-48 above, and further in view of Redfield et al. (US 6479466).

Rejection is maintained for the reasons of record.

Claim 14 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Styczynski et al. in view of Black as applied to claims 1, 7, 33-48 above, and further in view of Freeman et al. (US 6110458).

Rejection is maintained for the reasons of record.

Allowable Subject Matter

Claims 2-6, 8, 9, 12-13, 15-19, 21-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed October 21, 2004 have been fully considered but they are not persuasive.

Applicants assert that a skilled artisan would not be motivated to combine the AZT from Black with the composition in Styczynskin because "depilatory compositions work differently from compositions that interfere with the biological mechanism of hair growth". The argument is unpersuasive because there is nothing in the record to support the proposition that two different mechanisms cannot currently function. On the other hand, it is viewed obvious that the routineer would have had a motivation to

combine the two references because both are directed to the same field of endeavor, i.e., to remove or suppress the growth of body hair.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the rationale on which the rejection is based is not an impermissible hindsight because the facts and motivation to support the rejection are found solely on the references that were available to skilled artisans in hair removing composition art at the time of the present invention.

Conclusion

Claims 1, 6, 10, 11, 14, 20, 33-48 are rejected.

Claims 2-5, 7-9, 12, 13, 15-19 and 21-32 are objected to.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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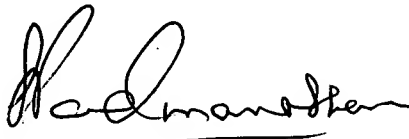
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER